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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,303	10/10/2003	Terry J. Sills	301-002	3325

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EXAMINER

GREEN, BRIAN

ART UNIT	PAPER NUMBER
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3611

DATE MAILED: 04/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/684,303	Applicant(s) SILLS, TERRY J.	
	Examiner Brian K. Green	Art Unit 3611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,7-15 and 21-27 is/are pending in the application.
- 4a) Of the above claim(s) 10-15 and 21-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,7-9,24-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Applicant's election without traverse of Species I. (Figures 1-3) in the reply filed on Aug. 15, 2005 is acknowledged.

Claims 10-15 and 21-23 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on Aug. 15, 2005.

Specification

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification fails to indicate that the display comprises a non-contoured edge located opposite the bound edge as defined in claims 1 and 24.

Claim Rejections - 35 USC § 112

Claims 1-5, 7-9, and 24-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 7, and claim 24, line 7, stating that the edge opposite the bound edge is "non-contoured" is misdescriptive since all edges have a contour. A contour is simply an outline or external boundary of a form. In claim 1, line 8, claims 2-7, line 1, and claim 8, lines 1-2, "at least one reference marker" is confusing since it is not clear whether the applicant is referring to

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the “at least one reference marker” defined earlier. In claim 8, lines 1-2, and claim 1, line 9, “at least one display” is confusing since it is not clear whether the applicant is referring to the “at least one display” defined in claim 1, line 4.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,8,9,24, and 27, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Jackson (U.S. Patent No. 5,464,672).

Jackson shows in figures 1-2 an object orientation system comprising at least one display (the notepad which includes a plurality of sheets 12) comprising a bound edge (the adhesive 14 binds the edges of the sheets together), a non-contoured edge (the reference markers 18 are attached directly to the edge of the sheets 12 and the edges which include the reference markers of Jackson are considered to be as much “non-contoured” as the applicant’s edge), and at least one reference marker (18) located only on the “non-contoured” edge of the display. In regard to claims 8,9, and 27, Jackson discloses that the notepad includes Post-It note sheets, see column 1, lines 5-15.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1,8,9,24, and 27 are rejected under 35 U.S.C. 102(e) as being anticipated by Sabella (U.S. Patent No. 6,703,096).

Sabella shows in figures 1-3 an object orientation system comprising at least one display (the notepad which includes a plurality of sheets 16a, 16b, 16c, etc.) comprising a bound edge (the adhesive 21 binds the sheets together), a non-contoured edge (19 which are considered to be as much “non-contoured” as the applicant’s edge), and at least one reference marker (23a) on the non-contoured edge. Only the indicia (23a) on the edge (19) is considered to be a “reference marker”. In regard to claims 8,9, and 27, Sabella discloses that the notepad includes adhesive sheets (16) which are the same as Post-It note sheets.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-5,7,25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson (U.S. Patent No. 5,464,672).

Jackson discloses the applicant’s basic inventive concept except for the particular message/indicia used in forming the reference marker, i.e. smiling or frowning face. It would have been obvious to one skilled in the art to modify Jackson by making the marker in the form of a smiling or frowning face since it is considered an obvious matter of design to vary the

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indicia displayed as desired. The particular indicia displayed is not considered to be a patentable feature.

Claims 2-5,7,25, and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sabella (U.S. Patent No. 6,703,096).

Sabella discloses the applicant's basic inventive concept except for the particular message/indicia used in forming the reference marker, i.e. smiling or frowning face. It would have been obvious to one skilled in the art to modify Jackson by making the marker in the form of a smiling or frowning face since it is considered an obvious matter of design to vary the indicia displayed as desired. The particular indicia displayed is not considered to be a patentable feature.

Response to Arguments

Applicant's arguments filed Feb. 22, 2006 have been fully considered but they are not persuasive.

In regard to claim 1, the applicant argues that the phrase "at least one reference marker" is not indefinite since one skilled in the art would be able to ascertain the scope of the claim without applicant needing to amend the claims to insert the words "the" or "said" before the second occurrences of these phrases. The examiner disagrees since the word "the" or "said" makes it clear whether the second occurrence of a word or phrase is the same as an earlier mentioned word or phrase. The language appearing in claim 1 is still considered to be indefinite since it is not clear whether the applicant is referring to the earlier mentioned "at least one

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reference marker” or is defining an additional “at least one reference marker”. The same applies to the term “at least one display”.

The applicant argues that Jackson does not disclose a display with a reference marker that is only located on a non-contoured edge of the notepad. The examiner believes that this phrase in claims 1 and 24 is indefinite since the applicant’s edge is a contoured edge, i.e. all edges have a contoured edge. Whether the edge is straight or curved or zigzag, etc. it still has a contour. Contour simply means the outline or external boundary of a form. As best understood, the edge of Jackson is considered to be as much “non-contoured” as the applicant’s edge.

The applicant argues that Sabella does not disclose a display with a reference marker that is only located on a non-contoured edge of the display. The examiner disagrees since only the indicia (23a) located on the edge (19) is considered to be a reference marker and the edge (19) is considered to be as much “non-contoured” as the applicant’s “non-contoured” edge. The examiner also believes that stating that the edge is “non-contoured” in claims 1 and 24 is indefinite since the applicant’s edge is a contoured edge, i.e. all edges have a contoured edge. Whether the edge is straight or curved or zigzag, etc. it still has a contour. Contour simply means the outline or external boundary of a form.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after


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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K. Green whose telephone number is (571) 272-6644. The examiner can normally be reached on M-F 7am-3:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lesley Morris can be reached on (571) 272-6651. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


BRIAN K. GREEN
PRIMARY EXAMINER

Bkg
April 20, 2006